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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,457	06/11/2001	Thomas Buchel	P/167-133	7346

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/807,457

Applicant(s)

BUCHEL, THOMAS

Examiner

Rabon Sergeant

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1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 16-18, 22, 25, 27-30, 33-38 and 40-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 16-18, 22, 25, 27-30, 33-38 and 40-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/22/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on May 19, 2005 and July 15, 2005 has been entered.
2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Adequate antecedence has not been provided for the various amendments to claims 1 and 51-53 pertaining to the starting components and respective OH and NCO groups. It is not seen that applicant's prior response adequately addressed this issue.
3. Claim 53 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claim 53, there is a word omission within line 8, after "OH groups and".

4. Claims 1-13, 16-18, 22, 25, 27-30, 33-38, and 40-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 1-13, 16-18, 22, 25, 27-30, 33-38, and 40-51, applicant has failed to provide support for the amendments regarding the language, "other than comminuting to a

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powder”, as these amendments pertain to when the “comminuting to a powder” is excluded. The examiner has reviewed the specification, and support for excluding the argued comminuting operation appears only at page 4, lines 20-23 and page 5, line 2. However, the specification only states that comminuting to a powder is excluded after the polyaddition reaction and that powder-form preforms are excluded. Neither of these disclosures support excluding comminuting to a powder prior to or during polyaddition. With respect to claims 28 and 36, it is unclear if the “comminuting” language pertains only to the preform and not to pre-preform components.

With respect to claims 52 and 53, adequate support has not been provided for the limitation, “wherein the mixture before or during the polyaddition reaction is subjected to a foaming step”. The examiner has reviewed the specification, and the only disclosure with respect to foaming appears at page 7, lines 1-4; however, this disclosure fails to specify when or how the foaming is performed.

5. Claims 52 and 53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant has failed to provide adequate enablement for the limitation, “wherein the mixture before or during the polyaddition reaction is subjected to a foaming step”. The examiner has reviewed the specification, and the only disclosure with respect to foaming appears at page 7, lines 1-4; however, this disclosure fails to specify when or how the foaming is performed.


6. The 35 U.S.C. 102 rejection in view of EP 262488 has been withdrawn in view of applicant’s definition of a “preform” at page 5, lines 1-5 of the specification, wherein applicant

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states that the form of powder is excluded, and in view of the requirement that the preform be free of extractable monomers with reactive double bonds. In view of this definition and this requirement, the examiner's previous argument that the filler (disclosed as being in particulate or powder form within the reference) within the composition or the composition (disclosed as containing compounds that constitute unsaturated extractable monomers) containing the filler constitutes a preform is considered untenable and has been withdrawn.

7. The 35 U.S.C. 103 rejection in view of Verleg et al. ('832) or Smith ('402) or EP 269071, further in view of EP 262488 has been withdrawn in view of applicant's arguments and the position set forth above within paragraph 6.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

  
RABON SERGENT  
PRIMARY EXAMINER

R. Sergent  
September 20, 2005